




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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,579	02/23/2004	Steven Allen Carlson	1141.009	4364
7590	11/22/2004			
Optodot Corporation Attn: Intellectual Property Department Suite 305 214 Lincoln Street Allston, MA 02134			EXAMINER TRA, TUYEN Q	
			ART UNIT 2873	PAPER NUMBER
DATE MAILED: 11/22/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/786,579	CARLSON ET AL.	
	Examiner	Art Unit	
	Tuyen Q Tra	2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims have been renumbered as follow:

Page 56, claims 23-42 have been renumbered as 24-43.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-60 of US Patent. 6,380,059.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose an optical device having a first state of transmitting and

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a second state of not transmitting, said shutter comprising a photon-absorbing layer, wherein said photon-absorbing layer comprises an organic free radical compound.

Since the '059 patent teach a low absorption at a wavelength and a high absorption wavelength as transmitting and not transmitting of the wavelength, and would render the claims obvious to one ordinary skill in the art over the claims of US Patent 6,380,059.

4. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of US Patent. 6,757,094.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose an optical device having a first state of transmitting and a second state of not transmitting, said shutter comprising a photon-absorbing layer, wherein said photon-absorbing layer comprises an organic free radical compound.

Since the '094 patent teach a low absorption at a wavelength and a high absorption wavelength as transmitting and not transmitting of the wavelength, and would render the claims obvious to one ordinary skill in the art over the claims of US Patent 6,757,094.

5. Claims 23-43 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53-60 of US Patent. 6,583,916.

Although the conflicting claims are not identical, they are not patentably distinct from each other because both disclose method for a) providing an input optical path; providing an output optical path; (b) interposing an optical modulator for modulating an optical signal at a wavelength in said input optical path between a first state of transmitting said optical signal into said output optical path and a second state of not transmitting said optical signal into said output optical path, wherein said modulator comprises an active modulating material that comprises an organic free radical

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compound in at least one of said first and second states; (c) providing an optical signal in said input optical path; and (d) reversibly switching said active modulating material between said first and second states to modulate said optical signal in said output optical path. Since the '916 patent teach method of a) providing a free-space optical switch device, comprising an optical shutter disposed between an optical input path and a first and second optical output paths, the optical shutter being switchable between a transparent state in which the light from the input path is transmitted through the optical shutter to said first output path, and a reflective state in which the light from the input path is reflected from said optical shutter to said second output path; (b) inputting an optical signal into the input path; (c) providing photons to switch said optical shutter reversibly between said transparent state and said reflective state in order to selectively direct said optical signal to a predetermined one of the output paths, and would render the claims obvious to one ordinary skill in the art over the claims of US Patent 6,538,916.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuyen Tra whose telephone number is (571) 272-2343. The examiner can normally be reached on Monday to Thursday from 8:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps, can be reached on (571) 272 - 2328. The fax number for this Group is (703) 872-9306.

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tt

November 5, 2004


Hung Xuan Dang
Primary Examiner